

REMARKS

Claims 1-22, 24-28, 30-38, 40 and 44 are pending in the present case. Claims 39 and 41-43 have been cancelled. The claims have been rejected as follows:

- Claims 1-22, 24-28, and 30-44 are rejected under 35 U.S.C. § 112, first paragraph;
- Claims 1-21 and 37-41 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- Claims 1-22, 24-28, and 30-44 are provisionally rejected on the ground nonstatutory obviousness-type double patenting over claims 1-36 of co-ending application serial no. 10/726,423;
- Claims 1, 2, 4-6, 8-10, 13, 14, 16, 17, 19-22, 24, 26-28, 38, 40, and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0199765 to Kohane et al. (hereinafter "*Kohane*" in view of U.S. Patent No. 6,363,486 to Knapton, III (hereinafter "*Knapton*");
- Claims 30-33, 37, 39, and 41-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of U.S. Patent Application Publication No. 2003/0074564 to Peterson (hereinafter "*Peterson*");
- Claims 3, 7, 18, and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of U.S. Patent No. 6,789,195 to Prihoda (hereinafter "*Prihoda*");
- Claims 11, 12, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of U.S. Patent Application Publication No. 2004/0068650 to Resnitzky (hereinafter "*Resnitzky*");
- Claim 34 is rejected under 35 U.S.C. § 1 03(a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Peterson* and *Prihoda*; and
- Claims 35 and 36 are rejected under 35 U.S.C. § 1 03 (a) as being unpatentable over *Kohane* in view of *Knapton* and further in view of *Peterson* and *Resnitzky*.

The undersigned submits the following remarks in support thereof to rebut the present rejections.

Rejection of Claims 1-22, 24-28, and 30-44 under 35 U.S.C. 112, 1st paragraph

Per Page 5 of the Final Office Action, this rejection is only relevant to those claims that include the language: "wherein input of the second-level access key by said medical service

provider is not required.” The undersigned submits that the only claims which contain this or similar language are claims 39 and 41-43. As indicated above in the section relating to amendments, these claims have been cancelled. Accordingly, the undersigned requests removal of this rejection with respect to the remaining claims.

Provisional Rejection of Claims 1-22, 24-28, and 30-44 for Non-Statutory Double Patenting

The undersigned continues to rebut this provisional rejection for the reasons set forth in the prior response to non-final Office Action. Specifically, claims 2 and 5 of application no. 10/726,423 do not disclose the limitation of the current claims that are directed to generating a second-level access key by the patient modifying the level of access of the first-level access key.

Rejection of Claims 1, 2, 4-6, 8-10, 13, 14, 16, 17, 19-22, 24, 26-28, 38, 40, and 44 as being Unpatentable Under 35 USC 103(a) over Kohane in view of Knapton, III

The undersigned respectfully asks the Office to reconsider this rejection. On Page 9 of the Final Office Action, the Office continues to admit that “Kohane et al. fails to explicitly disclose generating the second-level key by modifying the first level key.” This is actually a misstatement of the claim language. The claim language is precisely set forth below (emphasis added):

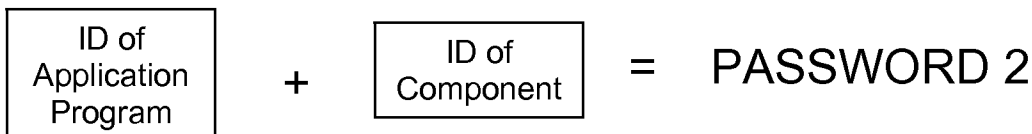
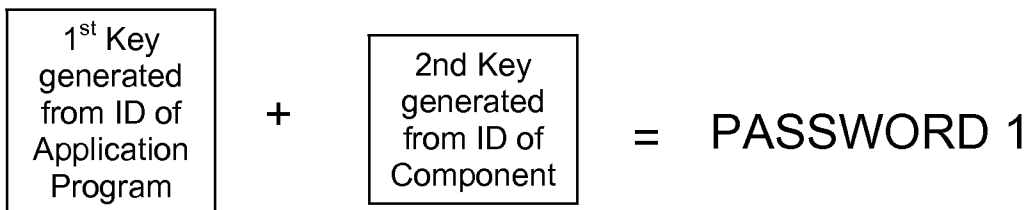
- “generating a second-level access key by the patient *modifying the level of access of the first-level access key*” (claim 1)
- “generating, by the key organization system, a second-level access key by *modifying the level of access of the first-level access key*” (claim 16)
- “generate a second-level access key by *modifying the level of access of the first-level access key*” (claim 22)
- “generate a second-level access key by *modifying the level of access of the first-level access key* as specified in the received request from said patient” (claim 30)

In the absence of the limitations above from the teachings of Kohane, the Office cites to portions of the Knapton reference. Specifically, the Office cites to Column 2, lines 24-43 as follows:

25 An embodiment of the present invention is a method of generating a password for controlling usage of a software component by an application program. A first key is created from an identifier of the application program, a second key is created from an identifier of the component, and the password is created from the first and second keys.

30 Another embodiment of the present invention is a method of controlling the usage of a software component with an application program in a computer system. The method includes obtaining an identifier of the application program and generating a first password from the application pro-
 35 gram identifier and an identifier of the component. The method also includes registering the component with the application program, generating, by the application program, a second password from the application program identifier and the component identifier, comparing the first
 40 password and the second password; and allowing use of the component with the application program on the computer system when the first password matches the second password.

In the response filed in October of 2009, it was pointed out that this portion of Knapton clearly does not describe modifying access of a first-level key to generate a second-level key. Further, Knapton never described modification of access. Further, the paragraphs cited above do not describe at all any modification of a first key or password or access level of a first key or password to generate a second key or password. The following schematics are illustrative of the cited paragraphs from Knapton.



PASSWORD 1 = PASSWORD 2: Grant Application Program
Access to Component

PASSWORD 1 ≠ PASSWORD 2: Do Not Grant Application
Program Access
to Component

As described and as shown, there is simply no discussion of modifying access, keys or passwords to create a different key or password.

On page 2 of the present Office Action, the Office responds to the previous arguments as follows:

are generated in knapton the application program identifier and component identifier,” argument is not persuasive because, again, the applicant's piecemeal analysis of references not acceptable.

Kohane et al. discloses the document owner i.e. the patient/creator/individual (par. 37, 40, and 5-8) selecting confidential/medical records of his own and controlling the selected portions of his own medical record (par. 49-55) by providing different tokens to different health institutions and doctors (par. 7, and 49-53) by specifying access rights/roles (see par. 55-61 and fig. 3-6B), and Knapton, III discloses that generation of a password from first and second key (see col. 2 lines 24-43) and further discloses that password is generated from different information (see col. 2 lines 24-43).

With all due respect, the Office’s statement here is not responsive to the arguments. It is the Office’s burden under 35 USC 103 to provide a clear articulation of the reasons why the claims are obvious in view of Kohane et al. and Knapton. *See* MPEP 2142. The Office admitted that the limitations under discussion are not taught by Kohane. And the Office does not deny that Knapton also does not disclose the limitations at issue. Accordingly, the Office must now articulate how this clear difference between the claims and the cited prior art would still have been obvious. The burden is on the Office to bridge this gap. *See* MPEP 2141(III). In MPEP Section 2143, some exemplary rationales that may support a conclusion of obviousness are found:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The rationale provided by the Office is:

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Knapton, III within the system of Kohane et al. because they are analogous in access control. One would have been motivated to modify the teachings to generate the second key based on first access information.

None of the exemplary rationales (A)-(G) suggest that simply being in an analogous art would support modification of a reference or references to arrive at the claimed invention as suggested by the Office Action. Because neither reference actually discloses the limitations directed to modification of access level of a first key to generate a second key, the Office's burden is in some ways higher than just having to provide rationale for combining references. The Office actually needs to provide a clear rationale as to how an entire limitation - missing from both references - would have been obvious when those same references are combined. The undersigned submits that the Office has failed to meet this burden in this case. The rationale does not fill the substantial gap of making up for a wholly absent limitation that is present in all of the claims.

Rejection of Claims 30-33, 37, 39, and 41-43 as being Unpatentable Under 35 USC 103(a) over Kohane in view of Knapton, III and Peterson

Adding Peterson to the combination of Kohan and Knapton does not cure the deficiencies thereof. In addition to the arguments above, the undersigned incorporates herein the additional arguments presented in the prior response rebutting the Office's assertion that this combination renders the remaining claims unpatentable.

Rejection of Claims 3, 7, 18, and 25 as being Unpatentable Under 35 USC 103(a) over Kohane in view of Knapton, III and Prihoda

Adding Prihoda to the combination of Kohan and Knapton does not cure the deficiencies thereof. For the reasons stated herein, the undersigned submits that these dependent claims are allowable.

Rejection of Claims 11, 12 and 15 as being Unpatentable Under 35 USC 103(a) over Kohane in view of Knapton, III and Resnitzky

Adding Resnitzky to the combination of Kohan and Knapton does not cure the deficiencies thereof. For the reasons stated herein, the undersigned submits that these dependent claims are allowable.

Rejection of Claim 34 as being Unpatentable Under 35 USC 103(a) over Kohane in view of Knapton, III, Peterson and Prihoda

For the reasons stated herein, the undersigned submits that this dependent claim is allowable.

Rejection of Claim 35 and 36 as being Unpatentable Under 35 USC 103(a) over Kohane in view of Knapton, III, Peterson and Resnitzky

For the reasons stated herein, the undersigned submits that these dependent claims are allowable.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 50-4402.

Respectfully submitted,

Date: May 11, 2010
KING & SPALDING LLP
1700 Pennsylvania Ave., NW
Washington, DC 20006
(202) 626-8978

By: /Dawn-Marie Bey - 44,442/
Dawn-Marie Bey
Registration No. 44,442